



3-19-01

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nancy Carrasco, Orsolya Dohan, Uygur H. Tazebay,
and Irene L. Wapnir

Serial No.: 09/519,959

Filed: March 7, 2000

For: METHODS FOR THE DIAGNOSIS AND TREATMENT
OF BREAST CANCER

Group Art Unit: 1642

Examiner: Stephen L. Rawlings, Ph.D.

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Date of Deposit: March 16, 2001

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Signature: Lisa M. Melanson

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**COMMUNICATION IN RESPONSE TO 01/19/01 OFFICE ACTION, PETITION FOR
ONE-MONTH EXTENSION OF TIME, AND INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Communication is submitted in response to the Office Action issued on January 19, 2001 in connection with the above-identified application. A response to the Office Action was due on February 19, 2001. Applicants hereby petition for a one-month extension of time for filing a response to the Office Action. A check is enclosed to cover the \$55.00 fee for a one-month extension of time. Accordingly, a response to the Office Action is now due on March 19, 2001, and this Communication is being timely filed.

Restriction Requirement

In response to the Restriction Requirement set forth in the Office Action, applicants' undersigned attorney, on behalf of applicants, hereby elects to prosecute Group I, Claims 1-6, with traverse. However, applicants respectfully request that the

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Examiner reconsider and withdraw the restriction requirement, and examine the claims of Group II (Claims 1 and 7-9) and the claims of Group III (Claims 1 and 10-11) together with the claims of Group I.

The claims of Group I are directed to a method of diagnosing breast cancer by detecting expression of mgNIS, wherein mgNIS is detected using an agent that is reactive with mgNIS. The claims of Group II are directed to a method of diagnosing breast cancer by detecting expression of mgNIS, wherein mgNIS is detected using a nucleic acid probe. The claims of Group III are directed to a method of diagnosing breast cancer by detecting expression of mgNIS, wherein mgNIS is detected using a detectable agent that is selectively taken up by mgNIS.

Applicants submit that a search for prior art relating to the diagnosis of breast cancer by detecting expression of mgNIS would necessarily lead to a finding of prior art directed to methods of detecting expression of mgNIS using an agent reactive with mgNIS (Group I), a nucleic acid probe (Group II), and a detectable agent that is selectively taken up by mgNIS (Group III), if such prior art were available. Accordingly, applicants submit that it would not be an undue burden on the Examiner to search and examine the claims of Groups I, II, and III together.

For these reasons, applicants respectfully request that the Examiner consider the claims of Groups II and III together with the claims of Group I in his examination of the application. Should the Examiner accept applicants' foregoing arguments, and examine the claims of Groups II and III together with the claims of Group I, applicants' undersigned attorney, on behalf of applicants, further elects examination of radioiodide as the single disclosed species in Group III.

Information Disclosure Statement

Pursuant to 37 C.F.R. §§§ 1.56, 1.97, and 1.98, applicants enclose herewith Forms PTO/SB/08A and PTO/SB/08B, containing references which may be deemed



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relevant to the above-identified application, along with a copy of each of the references cited therein. The enclosed items are made of record to assist the U.S. Patent and Trademark Office in its examination of the above-identified application. The Examiner is respectfully requested fully to consider the enclosed items, and independently to assess their teachings.

No fee, other than the \$55.00 fee for a one-month extension of time and the \$180.00 fee for filing an Information Disclosure Statement, is deemed necessary in connection with the filing of this Communication. If any additional fee is required to consider the IDS or preserve the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

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Dated: March 16, 2001
New York, New York